

REMARKS

At the time of the Office Action dated April 6, 2006, claims 1-16 were pending in this application. Of those claims, claims 1-2, 4-8, 11-12, and 14-16 have been rejected. Applicants acknowledge, with appreciation, the Examiner's indication that claims 3, 9-10, and 13 contain allowable subject matter.

On pages 2 and 3 of the Office Action, the Examiner made certain representations with regard to Applicants providing additional prior art. In response, Applicants submit the duty of disclosure requirements of 37 C.F.R. § 1.56 have been met.

On page 3 of the Office Action the Examiner asserted that "the title should be more specific to differentiate the invention from similar inventions in the patent literature." In response, Applicants submit that the Title is "as short and specific as possible," as required by 37 C.F.R. § 1.71. Applicants also note that the Abstract already includes the language suggested by the Examiner. In this regard, the Abstract and the claims provide ample differentiation between the invention and similar inventions in the patent literature.

**CLAIMS 1, 4-6, 11 AND 14-16 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY "WORKLOADS: POLYMIX - 2" (HEREINAFTER POLYMIX)**

On pages 4 and 5 of the Office Action, the Examiner asserted that PolyMix discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in PolyMix being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Claim 1

Despite this requirement, the Examiner's statement of the rejection ignores the claimed limitations. For example, claims 1 and 11 each recite a "current cache size" and a "contemporaneously experienced trace footprint." The Examiner's statement of the rejection only addresses a "cache size" and "a trace" without any mention that the cache size is current or that the trace footprint is contemporaneously experienced. Moreover, it does not appear that PolyMix teaches these limitations because "PolyMix -2" is described as "a new model for simulating proxy load" (emphasis added).

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

Moreover, Applicants note the following statement by the Examiner:

The steps of selecting an optimal hit rate and computing an optimal cache size are inherent in the WEB disclosure because from the table, for any given/selected "optimal" hit rate/ratio, the optimal cache size is calculated as shown in the "cache size" column. For example, if the selected hit rate/ratio is 8.5, then the optimal cache size for that selected hit rate is 10.

Applicants submit that the Examiner's reliance upon the doctrine of inherency to disclose the claimed computing and selecting steps is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.³ To establish inherency, the extrinsic evidence must make clear that the missing function must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁴ Furthermore, reference is made to ex parte Schricker,⁵ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where such a teaching or suggestion appears in the prior art. Thus, the Examiner has not established that these limitation are inherently disclosed by PolyMix. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

³ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁴ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

⁵ 56 USPQ2d 1723, 1725 (BPAI 2000).

Thus, for the reasons stated above, Applicants submit that the Examiner has failed to establish that Chase identically discloses the claimed invention, as recited in independent claims 1 and 11, within the meaning of 35 U.S.C. § 102. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 4-6, 11, and 14-16 under 35 U.S.C. § 102 for obviousness based upon PolyMix.

CLAIMS 2, 7-8, AND 12 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON POLYMIX

On pages 5 and 6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify PolyMix to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 2 and 12 respectively depend from independent claims 1 and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 11 under 35 U.S.C. § 102 for anticipation based upon PolyMix.

With regard to claim 7, the Examiner admitted that PolyMix fails to identically disclose the claimed invention. The Examiner then asserted:

However, it would have been obvious to one of ordinary skill in the art at the time of the current invention was made to implement this method/model steps taught by WEB into a system and connect it via a communicative link as claimed so the system can be used to calculate the optimum cache size for one or more servers(s) without running the software simulation.

Applicants note that the Examiner's asserted motivation to combine is absent any factual support.

As previously noted, PolyMix teaches a model for simulating proxy load, not a system for selecting a cache memory allocation to provide an optimized target cache hit rate in a caching component of a

content delivery system. Nowhere has the Examiner pointed to any teachings or suggestions that the simulation model taught by PolyMix can be employed in the claimed system. Since the Examiner's assertion is not derived from the teachings or suggestions of the applied prior art, the only apparent teaching, from which the Examiner's assertion can be derived, is in Applicants' disclosure, which, of course, can not be properly relied upon by the Examiner to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103.⁶ Applicants, therefore, respectfully submits that the imposed rejection of claims 2, 7-8, and 12 under 35 U.S.C. § 103 for obviousness based upon PolyMix is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

⁶ Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Application No.: 10/733,659

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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